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EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,983

Applicant(s)

GILHULY ET AL.

Examiner

Bradley Edelman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-81 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>21 pages total</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's response filed on December 20, 2004. That response was in response to Examiner's restriction requirement sent on November 30, 2004. Claims 1-81 are presented for further examination. Note that a new examiner has been assigned to this application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-7, 8-9, 24-43, 46-62, 71-78, and 81 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 8, 9-28, 29-45, 46-53, and 54 of copending Application No. 10/671,162 in view of Liao et al. (U.S. Patent No. 6,148,405, hereinafter "Liao").

In considering these claims, the following table maps out the corresponding claims in the two applications. The claims are identical, except that the claims in the

present application include a step of "encrypting" data items at the redirector host system before forwarding the data items to the mobile device (and correspondingly decrypting encrypted reply messages sent from the mobile device and received at the host system). These additional steps of encrypting and decrypting data items at a host system are well known, as evidenced by Liao (col. 3, lines 58-67), and would have been obvious to include in the '162 claims to increase the security of the system.

Present Application

Application No. 10/671,162

<p>Claim 1:</p> <p>A method of redirecting data items from a messaging host system to a user's mobile device, comprising the steps of:</p> <p> detecting a new data item for the user at the messaging host system;</p> <p> forwarding a copy of the new data item to a redirector host system;</p> <p> determining whether the new data item should be redirected from the redirector host system to the user's mobile device;</p> <p>and</p> <p> if the new data item should be redirected, then <u>encrypting the new data item to form an encrypted new data item</u>;</p>	<p>Claim 1:</p> <p>A method of redirecting data items from a messaging host system to a user's mobile device, comprising the steps of:</p> <p> detecting a new data item for the user at the messaging host system;</p> <p> forwarding a copy of the new data item to a redirector host system;</p> <p> determining whether the new data item should be redirected from the redirector host system to the user's mobile device;</p> <p>and</p> <p> if the new data item should be redirected, then</p>
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<u>and</u> packaging the <u>encrypted</u> new data item into an electronic envelope and transmitting the electronic envelope to the user's mobile device.	packaging the new data item into an electronic envelope and transmitting the electronic envelope to the user's mobile device.
Claims 2-7	Claims 2-7
Claims 8 & 9	Claim 8
Claims 24-43	Claims 9-28
Claims 46-62	Claims 29-45
Claims 71-78	Claims 46-53
Claim 81	Claim 54

This is a provisional obviousness-type double patenting rejection.

Claim Objections

2. Claim 62 is objected to because of the following informalities: the claim appears to have a typographical error – i.e. “(original)” appears in the middle of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 13-14, 21, 24-61, 63-68, and 70-81 are rejected under 35 U.S.C.

103(a) as being unpatentable over AirMobile Communication Server Guide

("AirMobile Software for Lotus cc:Mail Wireless," Motorola Publication, 1995,

hereinafter "AirMobile"), in view of Liao et al. (U.S. Patent No. 6,148,405, hereinafter "Liao").

In considering claim 1, AirMobile discloses the claimed redirection method including detecting a new data item for the user at the messaging host system (cc:Mail Post Office server, Fig. 1), forwarding a copy of the data item to a redirector host system (AirMobile Wireless for cc:Mail Server, Fig. 1), determining if the new data item should be redirected from the redirector host system to the user's mobile device, and if so, then packaging the data item in an electronic envelope and transmitting the electronic envelope to the user's mobile device (pp. 10-11, describing the messaging system and the filtering of messages at the redirector host system, see also pp. 25-26, 35).

AirMobile further discloses that messages are sent in a "secure and authenticated" manner between the LAN-based server and the mobile wireless device – see p. 25. However, AirMobile does not explicitly state that the secure manner includes encryption. Nonetheless, encryption is a notoriously well-known device used to create secure channels between communicating systems, as evidenced by Liao. Liao discloses a system very similar to AirMobile wherein messages are sent from a server

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residing on a land-based network to a wireless mobile device, wherein the messages are encrypted at the land-based server to create a secure channel between the server and the wireless device (see col. 3, lines 58-67). Given this teaching, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using encryption at the mail server in the system taught by AirMobile to create the secure channel, because encryption is a very effective way to ensure that messages remain secure throughout their transmission. Therefore, it would have been obvious to encrypt the messages at the AirMobile Wireless for cc:Mail Server in the system taught by AirMobile.

Claims 2-5 are disclosed on page 10 of AirMobile.

In considering claims 6-7, AirMobile further discloses the step of configuring filtering rules and a user profile database at the redirector host system and allowing a user or administrator to remotely configure the filters and database remotely (pp. 11-12).

Claims 8-9 are further disclosed by the combination of AirMobile and Liao (see AirMobile, pp. 26-27).

In considering claim 10, Liao further discloses that the encryption includes using a cipher algorithm and a decryption key to decrypt the encrypted new data item (col. 7, lines 18-20, 60-61; col. 9, lines 4-9).

In considering claim 11, Liao further discloses generating the decryption key at the redirector host system and forwarding the key to the mobile device using a secure communications link (col. 9, lines 22-52).

Claims 13-14, and 21 are further disclosed by Liao (see cols. 7-10, describing in depth the process of sending keys between the mobile device and host to enable encryption and decryption between the two devices).

In considering claim 24, AirMobile further discloses sending replies from the mobile device to the redirector host system (p. 26, describing messages sent by the mobile device). Thus, given the teaching of Liao, it would have been obvious to include encryption and decryption of these messages from the mobile device to the host in the same way as the initial messages sent from the host to the mobile device, in order to enable two-way secure transactions.

In considering claim 25, the messages sent from the mobile device to the redirector server will necessarily be addressed using the address of the redirector host system.

Claims 26-27 disclose the analogous reverse steps as claim 1, and thus are rejected under the same rationale as claim 1.

In considering claim 28, the combined system of AirMobile and Liao, as described above, will necessarily complete the claimed steps of decrypting the encrypted reply received at the redirector host system, reconfiguring address information associated with the reply, and sending the reconfigured reply data to a destination using an electronic address included in the reply data item (i.e. the messages sent from the mobile device are intended for outside recipients, so must include the address of those recipients and must have addresses reconfigured upon redirection at the redirection host system).

In considering claim 29, AirMobile and Liao both further disclose the claimed gateway, and thus sending messages in the electronic envelope through the gateway (AirMobile, Fig. 1, wherein the "Mobidem" serves as the gateway; Liao, Fig. 1, wherein the "up.link gateway" is the gateway).

Claims 30-39 are disclosed in the same sections of AirMobile discussed previously.

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In considering claims 40-43, neither AirMobile nor Liao disclose that the e-mail server is part of an ISP. Nonetheless, Examiner takes Official notice that it is well known for ISPs to run e-mail servers. Thus, it would have been obvious for the e-mail systems taught by AirMobile and Liao to be run by an ISP because that would increase business with the ISP.

In considering claim 44, AirMobile further discloses that the redirector host system includes a further messaging host system (Fig. 1, cc:Mail PostOffice; cc:Mail router).

In considering claim 45, AirMobile further discloses that the redirector host system is incorporated with the messaging host system (Fig. 1, all host systems are cc:Mail).

In considering claims 46 and 47, Liao further discloses that the host system can be a Web server, which would include web-page interfaces. Thus, it would have been obvious to use a web-based interface to control the filtering in the AirMobile system because such an interface is ubiquitous and could be used anywhere in the world.

Claims 48, 49, 51, 52, and 57-59 are further disclosed by the sections of AirMobile previously discussed.

In considering claim 50, Examiner takes Official notice that compression of electronic messages is well known. Thus, it would have been obvious to compress the messages being sent from the redirector host system to the mobile device to conserve network bandwidth.

In considering claims 53 and 54, AirMobile further discloses an interface for redefining or turning on or off the filtering mechanism that includes an activation/deactivation switch for turning on or off forwarding of messages from the redirector host (i.e. the "Enable" feature, see fig. 2-5 for example). AirMobile further discloses that profiles and filters can be accessed remotely (pp. 11-12). Thus, given the teaching of use with a web server taught by Liao it would have been obvious to use a web-based interface to control the filtering and profiles in the AirMobile system because such an interface is ubiquitous and could be used anywhere in the world.

In considering claims 55 and 56, AirMobile further discloses that the user profile database verifies that users are authorized users (p. 17, "password") and additionally describes an access mechanism allowing an administrator to remotely configure and reconfigure the user profile database (pp. 11-12).

Claims 60-61, 63-68 and 70-79, and 81 are rejected for the same reasons discussed previously with regard to AirMobile and Liao.

In considering claim 80, AirMobile further discloses a plurality of messaging host systems coupled to the network for receiving data items associated with particular users and for forwarding the received data items to the predetermined address, wherein the redirector host system receives the forwarded data items from the plurality of messaging host systems and redirects those data items to each user's wireless mobile device (p. 13, "Note"). As with claim 1, it would have been obvious to include the encryption taught by Liao in the system taught by AirMobile.

4. Claims 15, 22, 23, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Liao, and further in view of Wright et al. (U.S. Patent No. 6,084,969).

In considering claims 15, 22, and 23, these claims present similar limitations as claims 13, 14, and 21, but describe the use of both public keys and private keys. Liao discloses using separate private keys, but does not describe using public keys. Nonetheless, as taught by Wright, using both public and private keys to enable secure communication between devices is well known. Wright discloses a system for providing a secure link between devices communicating across wired and wireless networks, wherein the session is secured through the passing and use of public and private keys (Abstract). Wright also discloses that either the shared secret key system or a private-public key system could be interchangeably used (col. 7, lines 16-30). Thus, it would have been obvious given the teaching of Wright to allow the use of private and public

keys in the system taught by Liao, based on Wright's assertion that they can be easily interchanged.

Claim 69 is rejected for the same reasons.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Liao, and further in view of RFC 2193 (IMAP4 Mailbox Referrals, September 1997).
6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Liao and Wright, and further in view of RFC 2193 (IMAP4 Mailbox Referrals, September 1997).

In considering claims 12 and 16, Liao further discloses the use of SSL for the communications (i.e. "https"). However, neither AirMobile nor Liao explicitly disclose the use of IMAP for forwarding the messages. Nonetheless, Liao does disclose using the Internet and AirMobile discloses forwarding e-mail, and the IMAP protocol is a well known protocol for forwarding e-mail over the Internet, as evidenced by RFC 2193. Thus, given that IMAP is a widely-used protocol for Internet-based e-mail, it would have been obvious to use it in the combined system of AirMobile and Liao to avoid the need to create an entirely new protocol.

7. Claim 62 is are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile, in view of Liao, and further in view of Infotech ("The Perils of E-Mail: Unsolicited Messages!" Infotech Update, New York, August 1997).

In considering claim 45, AirMobile discloses at the host system a program for transmitting user data items and a forwarding file containing a list of authorized users of the system, and the predetermined address to which the messaging host system will forward each user's data items (all of this is inherently part of the PostOffice server in order to forward messages received at the PostOffice server to the appropriate AirMobile server; see Fig. 1, pp. 11-13). However, AirMobile does not explicitly state what program is used for the message forwarding, and thus does not disclose a "sendmail" program. Nonetheless, sendmail programs for message forwarding are well known, as evidenced by Infotech (see p. 1, last paragraph). It would have been obvious to use the well-known sendmail program to forward the messages in the AirMobile and Liao combined system to avoid the need to create an entirely new mail forwarding program.

Allowable Subject Matter

Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose or render obvious the specific encryption key forwarding method using a separate computer system as taught by claims 17 and 19.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE
April 13, 2005